

REMARKS

Claims 1-26, 33, and 34 are currently pending in the application. Claims 1, 9, 23, and 33 have been amended. Applicants respectfully request reconsideration of the pending claims in view of the following remarks.

Claim Rejections – 35 U.S.C. § 102

The Examiner rejected Claim 33 under 35 U.S.C. § 102 as being anticipated by Amazon.com of May 21, 2002 (“Amazon”).

Independent Claim 33 has been amended to incorporate the subject matter of Claim 34. The Examiner rejected Claim 34 under 35 U.S.C. § 103 as being unpatentable over Amazon in view of design choice. The Examiner further indicates on pages 18-19 of the present Office action that “[i]t would have been an obvious matter of design choice to modify the selected group to include power tools of the same tool model since applicant has not disclosed that a combo kit containing at least two power tools of the same tool model solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with any other type or variation of power tools being included in the combo kit.”

Applicant respectfully disagrees. Amazon discloses preconfigured combination kits. Not one of the preconfigured combination kits illustrated or discussed in Amazon includes two tools of the same tool model. As noted on page 8, lines 12-23 of the present application, “a customer that repeatedly performs a single task may require multiple power tools of the same tool model instead of a variety of power tools representing different tool models.” The ability for a customer to select two of the same tool model at a combo kit price is a unique feature of the invention not previously available to customers, such as contractors. Previously, customers had to purchase two tools of the same tool model at the listed price for each tool.

For at least these reasons, the subject matter of amended independent Claim 33 is not obvious. Accordingly, independent Claim 33 is allowable.

Claim Rejections – 35 U.S.C. § 103

The Examiner rejected Claims 1-3 and 15 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,873,967 (“Kalagnanam”) in view of an article entitled “What a Find: The Essential Cordless Tools in One Kit,” authored by Mark Hetts in Seattle Times of December 5, 1999 (“Hetts”).

Kalagnanam does not disclose the subject matter of amended independent Claim 1 for at least the reasons noted by the Examiner on page 4 of the present Office action. In addition,

Kalagnanam does not disclose a method for providing a power tool combo kit from a provider to a customer, comprising at least the following elements:

- (a) receiving a selection from the customer of a plurality of power tools from the available group
- (b) configuring the selection of power tools as a combo kit having a particular price

Rather, Kalagnanam discloses an electronic shopping assistant having a shopping list generator that searches products in an online product catalog stored in a product database 114. The database 114 contains product records 115 that are used to generate the shopping list based on a shopper's input. The product records 115 include "one or more product identification numbers, one or more product names, one or more product categories, one or more product attribute values including product size, product color, product price, product gross margin percentage, on-hand inventory in weeks of supply, and one or more priority indices . . ." Col. 5, lines 34-41.

The input from the shopper includes "item choices, profiles, constraints, and limit price." Col. 5, lines 65-66. The profile constraints provide information about one or more recipients of products for which the shopper shops, the recipient information comprising an identification including name, gender, age and address, and product information including category, size, color and brand, and budget information. Col. 6, lines 1-4. "The shopping list constraints comprise one or more budget constraints that specify one or more conditions on a cost for individual product recipients and a total cost, one or more product constraints that specify one or more conditions for product attributes including category, size, color and brand, one or more inter-item constraints that specify one or more conditions on a relationship among products and their attributes, and one or more multiple choice constraints that specify one or more conditions on a number of products given to recipients." Col. 6, lines 4-15.

"The output handler 106 then provides recommended product lists 108 to the shopper 101. The recommended product lists include feasible item bundles based on the shopper's input constraints, limit price, etc. The list of product combinations may also comprise one or more products sold in one or more online stores that satisfy the constraints given by the electronic shopping assistant as a set. The electronic shopping assistant process compiles one or more lists of recommended product combinations received from one or more stores, to create one or more recommended product lists and displays one or more lists of recommended product combinations to shoppers. The electronic shopping assistant process provides an interactive interface for a shopper allowing the shopper to browse one or more lists of feasible

product bundles with products presented in one or more online product catalogs, and tag one or more products in the lists and the catalog. Using this interface, a shopper submits an input including one or more products tagged from the online product catalog and the feasible product bundles in a previous submission.” Col. 6, lines 15-35.

The shopper only provides input to the electronic shopping assistant related to characteristics of products and constraints. Based on these characteristics and constraints, the electronic shopping assistant generates a shopping list having a list of products that satisfy the characteristics and constraints. The shopper does not select ... a plurality of power tools from the available group, rather the shopping list generates a list of products that satisfy the shopper’s input. In addition, the electronic shopping assistant does not configure the selection of power tools as a combo kit having a particular price, because it does not allow for consumer selection of the power tools.

The Examiner indicates on page 3 of the present Office action that Col. 8, lines 23-44 discloses “receiving a list of item choices with constraints submitted by the shopper.”

Applicant respectfully disagrees. As noted in Col. 3, lines 24-32 of Kalagnanam, “[c]onstraint-based configuration technology allows the online product catalog to be represented declaratively by a hierarchy of dynamic classes, each corresponding to a product type. For each item choice, the input profile specifies a possible domain, or list of items in the product catalog which can match this profile. Constraint-based optimization provides fast and efficient algorithms for generating lists of recommended products for each item choice which satisfy all the shopping list constraints.”

The “item choice” is not a product selection, because if it were the product selection there would be no need to generate a list of recommended products. In other words, there would be no need for the invention disclosed in Kalagnanam. Instead, the consumer may select generic items such as pants or shirts. Then, based on the constraints, the shopping assistant will generate a shopping list of the specific pants or shirts products and generate a list for the consumer to pick and choose certain products or bundled packages to buy. There is still no selection of a plurality of products from the consumer that get configured into a combo kit.

Hetts does not cure the deficiencies of Kalagnanam. Hetts does not disclose a method for providing a power tool combo kit from a provider to a customer, comprising at least the following elements:

- (a) receiving a selection from the customer of a plurality of power tools from the available group
- (b) configuring the selection of power tools as a combo kit having a particular price

Rather, Hetts discloses a Home Project Combo Kit having three of the most commonly used power tools: a flashlight, a cordless, variable speed reversible drill/driver, and a 5 ½ " cordless circular saw.

Hetts only provides a preconfigured combo kit with no input from a consumer as to his or her most desirable tools.

Hetts does not allow for consumer selection of a plurality of power tools from an available group. Hetts also does not configure the customer-selected power tools because Hetts does not allow for consumer selection.

For at least these reasons, Kalagnanam and Hetts do not disclose the subject matter of Claim 1. Accordingly, independent Claim 1 is allowable. Claims 2-8 depend from Claim 1 and are allowable for at least the reasons Claim 1 is allowable. Claims 2-8 may be patentable for additional reasons not discussed herein.

Kalagnanam does not disclose the subject matter of independent Claim 15 for at least the reasons noted by the Examiner on page 6 of the present Office action. In addition, Kalagnanam does not disclose a method for providing a power tool combo kit from a provider to a customer comprising at least the following elements:

- (a) receiving a customer request of multiple requested power tools from the available group
- (b) providing a selected group of multiple selected power tools in response to the customer request, the selected group corresponding to the customer request

As discussed above, Kalagnanam discloses that the shopper only provides input to the electronic shopping assistant related to characteristics of products and constraints. Based on these characteristics and constraints, the electronic shopping assistant generates a shopping list having a list of products that satisfy the characteristics and constraints. The shopper does not select ... a plurality of power tools from the available group, rather the shopping list generates a list of products that satisfy the shopper's input. In addition, the electronic shopping assistant does not configure the selection of power tools as a combo kit having a particular price, because it does not allow for consumer selection of the power tools.

Hetts does not cure the deficiencies of Kalagnanam. Hetts does not disclose a method for providing a power tool combo kit from a provider to a customer comprising at least the following elements:

- (a) receiving a customer request of multiple requested power tools from the available group
- (b) providing a selected group of multiple selected power tools in response to the customer request, the selected group corresponding to the customer request

Hetts only provides a preconfigured combo kit with no input from a consumer as to his or her most desirable tools.

Hetts does not allow for consumer selection of a plurality of power tools from an available group. Hetts also does not configure the customer-selected power tools because Hetts does not allow for consumer selection.

For at least these reasons, Kalagnanam and Hetts do not disclose the subject matter of Claim 15. Accordingly, independent Claim 15 is allowable. Claims 16-22 depend from Claim 1 and are allowable for at least the reasons Claim 15 is allowable. Claims 16-22 may be patentable for additional reasons not discussed herein.

The Examiner rejected Claims 4 and 19 under 35 U.S.C. § 103 as being unpatentable over Kalagnanam and Hetts and further in view of U.S. Patent No. 5,148,094 ("Parks").

Claim 4 depends from Claim 1 and is allowable for at least the reasons Claim 1 is allowable.

As noted above Kalagnanam and Hetts do not disclose the subject matter of Claim 1. Parks does not cure the deficiencies of Kalagnanam and Hetts. Parks discloses a "universal charger which may be used to recharge battery pack designs available from a number of manufacturers." Col. 1, lines 47-49. "The battery charger includes a single receptacle (1) sized and shaped to accommodate one of a plurality of battery pack designs and (2) automatically adapted to receive alternate pack designs upon insertion of the alternate pack." Col. 2, lines 3-7.

Claim 4 further specifies "wherein the first-mentioned battery is incompatible with another of the selected cordless power tools, and a second battery is compatible with the other of the selected cordless power tools and incompatible with the at least one of the selected cordless power tools, the battery charger being operable to charge the first battery and the second battery."

Just because Parks discloses a battery charger capable of charging battery packs having different designs does not mean that the battery packs are incompatible with particular power

tools. There is no discussion in Parks that the battery packs are incompatible with particular power tools.

Accordingly, Claim 4 is allowable.

Claims 19 depends from Claim 15 and is allowable for at least the reasons Claim 15 is allowable. Claim 19 further specifies "wherein the combo kit includes the first-mentioned battery and a second battery, the first-mentioned battery being compatible with a first cordless power tool of the selected group and being incompatible with a second cordless power tools of the selected group, the second battery being compatible with the second cordless power tool and being incompatible with the first cordless power tool, the battery charger being operable to charge the first battery and the second battery."

As noted above Kalagnanam and Hetts do not disclose the subject matter of Claim 15. Parks does not cure the deficiencies of Kalagnanam and Hetts. As noted above, just because Parks discloses a battery charger capable of charging battery packs having different designs does not mean that the battery packs are incompatible with particular power tools. There is no discussion in Parks that the battery packs are incompatible with particular power tools.

Accordingly, Claim 19 is allowable.

The Examiner rejected Claims 5, 6, 16, 17, 23, 24, and 26 under 35 U.S.C. § 103 as being unpatentable over Kalagnanam and Hetts and further in view of design choice.

Claim 5 depends from Claim 1 and Claim 16 depends from Claim 15, and both claims are allowable for at least the reasons Claim 1 and Claim 15, respectively, are allowable. As noted above, Kalagnanam and Hetts do not disclose the subject matter of Claims 1 and 15.

Claims 5 and 16 further specify "wherein the selected group includes at least two power tools of the same tool type."

The Examiner further indicates on page 8 of the present Office action that "[i]t would have been an obvious matter of design choice to modify the selected group to include power tools of the same tool type since applicant has not disclosed that a combo kit containing at least two power tools of the same tool type solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with any other type or variation of power tools being included in the combo kit."

Applicant respectfully disagrees. Hetts discloses a preconfigured power tool combination kit of three different tools. As noted on page 8, lines 12-23 of the present application, "a customer that repeatedly performs a single task may require multiple power tools

of the same tool model instead of a variety of power tools representing different tool models.” The ability for a customer to select two of the same tool types at a combo kit price is a unique feature of the invention not previously available to customers, such as contractors. Previously, customers had to purchase two tools of the same tool model separately at the listed price for each tool.

Accordingly, Claims 5 and 16 are allowable.

Claim 6 depends from Claim 1 and Claim 17 depends from Claim 15, and both claims are allowable for at least the reasons Claim 1 and Claim 15, respectively, are allowable. As noted above, Kalagnanam and Hetts do not disclose the subject matter of Claims 1 and 15.

Claims 6 and 17 further specify “wherein the selected group includes at least two power tools of the same tool model.”

The Examiner further indicates on page 9 of the present Office action that “[i]t would have been an obvious matter of design choice to modify the selected group to include power tools of the same tool model since applicant has not disclosed that a combo kit containing at least two power tools of the same tool model solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with any other type or variation of power tools being included in the combo kit.”

Applicant respectfully disagrees. Hetts discloses a preconfigured power tool combination kit of three different tools. As noted on page 8, lines 12-23 of the present application, “a customer that repeatedly performs a single task may require multiple power tools of the same tool model instead of a variety of power tools representing different tool models.” The ability for a customer to select two of the same tool models at a combo kit price is a unique feature of the invention not previously available to customers, such as contractors. Previously, customers had to purchase two tools of the same tool model separately at the listed price for each tool.

Accordingly, Claims 6 and 17 are allowable.

Kalagnanam does not disclose the subject matter of amended independent Claim 23. More specifically, Kalagnanam does not disclose a method for providing a power tool combo, comprising at least the following elements:

(a) selecting a plurality of cordless power tools from the available group, the selected power tools including at least two power tools of the same tool type;

(b) selecting a battery charger, and at least one rechargeable battery compatible with the battery charger, the battery being compatible with at least one of the cordless power tools in the selected plurality of cordless power tools

As discussed above, Kalagnanam discloses that the shopper only provides input to the electronic shopping assistant related to characteristics of products and constraints. Based on these characteristics and constraints, the electronic shopping assistant generates a shopping list having a list of products that satisfy the characteristics and constraints. The shopper does not select ... a plurality of power tools from the available group, rather the shopping list generates a list of products that satisfy the shopper's input. In addition, the electronic shopping assistant does not configure the selection of power tools as a combo kit having a particular price, because it does not allow for consumer selection of the power tools.

Hetts does not cure the deficiencies of Kalagnanam. Hetts does not disclose a method for providing a power tool combo, comprising at least the following elements:

(a) selecting a plurality of cordless power tools from the available group, the selected power tools including at least two power tools of the same tool type;

(b) selecting a battery charger, and at least one rechargeable battery compatible with the battery charger, the battery being compatible with at least one of the cordless power tools in the selected plurality of cordless power tools

Hetts only provides a preconfigured combo kit with no input from a consumer as to his or her most desirable tools.

Hetts does not allow for consumer selection of a plurality of power tools from an available group. Hetts also does not configure the customer-selected power tools because Hetts does not allow for consumer selection.

For at least these reasons, Kalagnanam and Hetts do not disclose the subject matter of Claim 23. Accordingly, independent Claim 23 is allowable. Claims 24-26 depend from Claim 23 and are allowable for at least the reasons Claim 23 is allowable. Claims 24-26 may be patentable for additional reasons not discussed herein.

The Examiner rejected Claims 7, 21, and 22 under 35 U.S.C. § 103 as being unpatentable over Kalagnanam and Hetts and further in view of an article entitled "Hardware Show Broadens Mix" from Discount Store News on August 4, 1997 ("Hardware").

Claim 7 depends from Claim 1 and is allowable for at least the reasons Claim 1 is allowable. As discussed above, Kalagnanam and Hetts do not disclose the subject matter of Claim 1. Hardware does not cure the deficiencies of Kalagnanam and Hetts. Hardware

announces the annual Hardware Show at the McCormick Place in Chicago. Hardware also mentions some new products on display at the Show and several quotes from attendees and products they are looking for at the Show.

Claims 21 and 22 depend from Claim 15 and are allowable for at least the reasons Claim 15 is allowable. As discussed above, Kalagnanam and Hetts do not disclose the subject matter of Claim 15. Hardware does not cure the deficiencies of Kalagnanam and Hetts. Hardware announces the annual Hardware Show at the McCormick Place in Chicago. Hardware also mentions some new products on display at the Show and several quotes from attendees and products they are looking for at the Show.

The Examiner rejected Claims 8 and 18 under 35 U.S.C. § 103 as being unpatentable over Kalagnanam and Hetts and further in view of U.S. Patent No. 6,285,986 ("Andrews").

Claim 8 depends from Claim 1 and is allowable for at least the reasons Claim 1 is allowable. As discussed above, Kalagnanam and Hetts do not disclose the subject matter of Claim 1. Andrews does not cure the deficiencies of Kalagnanam and Hetts. Andrews discloses a method of interactive, automated registration, negotiation and marketing for combining products and services from one or more vendors together to be sold as a unit. The method allows vendors of products and services to post information about their products/services on a server for inclusion within bundles or collections of products and/or services. Bundle vendors then generate bundles of products/services by viewing and selecting available products/services from the posted available products/services. Members accessing the bundle system are able to view, select and purchase bundles generated and posted by the bundle vendors. Col. 2, line 59 – col. 3, line 3.

Andrews does not allow for consumer selection of the power tools to comprise the combo kit. Andrews also does not disclose that the selected power tools are configured as a combo kit. Accordingly, Claim 8 is allowable.

Claim 18 depends from Claim 15 and is allowable for at least the reasons Claim 15 is allowable. As discussed above, Kalagnanam and Hetts do not disclose the subject matter of Claim 15. Andrews does not cure the deficiencies of Kalagnanam and Hetts. As discussed above, Andrews does not allow for consumer selection of the power tools to comprise the combo kit. Andrews also does not disclose that the selected power tools are configured as a combo kit. Accordingly, Claim 18 is allowable.

The Examiner rejected Claims 9, 10, and 14 under 35 U.S.C. § 103 as being unpatentable over Kalagnanam in view of design choice.

Kalagnanam does not disclose the subject matter of amended independent Claim 9. More specifically, Kalagnanam does not disclose a method for providing a power tool combo kit, comprising at least the following elements:

- (a) selecting a plurality of power tools from the available group, the selected power tools including multiple power tools of the same tool type; and
- (b) providing a combo kit to the customer, the combo kit including the selected power tools.

As discussed above, Kalagnanam discloses that the shopper only provides input to the electronic shopping assistant related to characteristics of products and constraints. Based on these characteristics and constraints, the electronic shopping assistant generates a shopping list having a list of products that satisfy the characteristics and constraints. The shopper does not select ... a plurality of power tools from the available group, rather the shopping list generates a list of products that satisfy the shopper's input. In addition, the electronic shopping assistant does not configure the selection of power tools as a combo kit having a particular price, because it does not allow for consumer selection of the power tools.

The Examiner further indicates on page 13 of the present Office action that "[i]t would have been an obvious matter of design choice to modify the selected group to include power tools of the same tool type since applicant has not disclosed that a combo kit containing at least two power tools of the same tool type solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with any other type or variation of power tools being included in the combo kit."

Applicant respectfully disagrees. As noted on page 8, lines 12-23 of the present application, "a customer that repeatedly performs a single task may require multiple power tools of the same tool model instead of a variety of power tools representing different tool models." The ability for a customer to select two of the same tool type at a combo kit price is a unique feature of the invention not previously available to customers, such as contractors. Previously, customers had to purchase two tools of the same tool type separately at the listed price for each tool.

For at least these reasons, Kalagnanam does not disclose the subject matter of Claim 9. Accordingly, independent Claim 9 is allowable. Claims 10-14 depend from Claim 9 and are

allowable for at least the reasons Claim 9 is allowable. Claims 10-14 may be patentable for additional reasons not discussed herein.

The Examiner rejected Claims 11 and 12 under 35 U.S.C. § 103 as being unpatentable over Kalagnanam and design choice and further in view of Hetts.

Claims 11 and 12 depend from Claim 9 and are allowable for at least the reasons Claim 9 is allowable. Hetts does not cure the deficiencies of Kalagnanam. Hetts only provides a preconfigured combo kit with no input from a consumer as to his or her most desirable tools. Hetts does not allow for consumer selection of a plurality of power tools from an available group.

The Examiner rejected Claim 13 under 35 U.S.C. § 103 as being unpatentable over Kalagnanam and design choice and further in view of Andrews.

Claim 13 depends from Claim 9 and is allowable for at least the reasons Claim 9 is allowable. Andrews does not cure the deficiencies of Kalagnanam. As discussed above, Andrews does not allow for consumer selection of the power tools to comprise the combo kit. Andrews also does not disclose that the selected power tools are configured as a combo kit.

The Examiner rejected Claim 20 under 35 U.S.C. § 103 as being unpatentable over Kalagnanam, Hetts, and Parks, and further in view of U.S. Patent No. 7,339,350 ("Kubale").

Claim 20 depends from Claim 15 and is allowable for at least the reasons Claim 15 is allowable. As discussed above, Kalagnanam, Hetts, and Parks do not disclose the subject matter of Claim 15. Kubale does not cure the deficiencies of Kalagnanam, Hetts, and Parks.

The Examiner rejected Claim 25 under 35 U.S.C. § 103 as being unpatentable over Kalagnanam and Hetts and further in view of design choice and Andrews.

Claim 25 depends from Claim 23 and is allowable for at least the reasons Claim 23 is allowable. As discussed above, Kalagnanam and Hetts do not disclose the subject matter of Claim 23. Andrews does not cure the deficiencies of Kalagnanam and Hetts. Andrews does not allow for consumer selection of the power tools to comprise the combo kit. Andrews also does not disclose that the selected power tools are configured as a combo kit.

The Examiner rejected Claim 34 under 35 U.S.C. § 103 as being unpatentable over Amazon in view of design choice.

Claim 34 has been canceled. Therefore, this rejection is moot.

CONCLUSION

In view of the foregoing, entry of the present Amendment and allowance of the pending claims are respectfully requested. The undersigned is available for telephone consultation during normal business hours.

Respectfully submitted,

/julie a. haut/

Julie A. Haut
Reg. No. 51,789

Docket No. 066042-9378-00
Michael Best & Friedrich LLP
100 East Wisconsin Avenue
Suite 3300
Milwaukee, Wisconsin 53202-4108
414.271.6560